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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/695,550

10/28/2003

Michael James Justin

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05/02/2008

BIOMERIEUX, INC.
PATENT DEPARTMENT
100 RODOLPHE STREET
DURHAM, NC 27712

EXAMINER

LEVKOVICH, NATALIA A

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

05/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/695,550	Applicant(s) JUSTIN ET AL.	
	Examiner NATALIA LEVKOVICH	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/25/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/01/2008 has been entered.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1- 3 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by Seaton et al. (US 5798085).

With respect to claims 1-3 and 20, Seaton et al. disclose a transport system for automatic analyzer, comprising, as shown in Figures 1-3, boat 22 [‘motor-driven block’] engaging cards 28 [‘carriers’] accommodating sample wells 110 [‘features for holding test sample devices’] filled with growth media [‘test sample devices’], and a drive sub-system 100. Figure 3 also shows a plurality of optical interrupt apertures 112 [“position tracking features formed in the carrier”] arranged in alignment with the wells 110 [‘features for holding test sample devices’]. The system also includes an optical interrupt detector 882 [‘position tracking sensor’] which senses the radiation transmitted through the apertures 112 and “and sends a signal to the control system to cause the motor 708 to stop. When the motor 708 stops, the first column of wells 110 in the card 28 are positioned directly opposite a set of eight transmittance LEDs in the transmittance substation 802 which conduct transmittance testing of the column of wells in the card 28” (Col.11, lines 45-55).

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Note that lift pins are not positively recited as a part of the claimed invention and, therefore, are not accorded patentable weight.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as obvious over Seaton et al. Seaton teaches that , to facilitate the sliding motion, the slot 720 [‘replaceable wear strip’], is made from a ‘low friction material such as Delrin or given a low friction coating’ (Col. 10, lines 66 plus). Although Seaton does not teach the use of such low friction protective elements along the longitudinal path of the drive sub-system 100, it would have been within the ordinary skill of an artisan at the time the invention was made to have modified the apparatus of Seaton so as to employ low friction strips in the drive sub-system 100, in order to facilitate the movement of the boat and to reduce the wear of the contacting surfaces during the movement.

7. Claim 4 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Seaton et al. in view of Karl et al. (US 5891396).

The drive sub-system 100 is generally illustrated in Figures 1 and 2 which show the major mechanical components of the sub-system not indexed. Karl et al. disclose a transport system for automatic analyzer. Figures 1 and 2 of Karl appear to be identical to those of Seaton et al. The drive sub-system 100 is further illustrated in Figures 6-7 of Karl et al. The sub-system is shown to include shaft 42; raised ridges 37 and a raised rim 39 [‘guides’] parallel to the shaft; stepper motor 48 [‘servomotor’]; L-shaped “bearing mount” (not indexed) accommodating motor 54; the ‘mount’ having an opening [‘threaded member’,

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not indexed] for engaging the shaft and paddle 38 ['slide']. It appears that the drive sub-system 100 of Seaton et al. includes the above discussed mechanical feature, as taught by Karl. It would have been also within the ordinary skill of an artisan at the time the invention was made to have employed such commonly used elements of mechanical drivers as motors, guides, bearing mounts, slides, bolts, etc., in the drive sub-system of Seaton, in order to move sample carriers from station to station.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-2 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending application 10/695038.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn to a carrier for moving sample devices including features for holding test sample devices arranged in registration with optical positioning features formed in the carrier. The difference is a drive sub-system including a motor-driven block engaging the carrier . It would have been obvious to one having ordinary skill in the art to modify the invention of claim 1 of 10/695038 to employ such a motor driven block as a common electro-mechanical means for sample transportation, routinely used in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

10. Applicant's arguments filed 02/01/2008 have been fully considered but they are moot in view of new grounds of rejection.

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Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalia Levkovich whose telephone number is 571-272-2462.

The examiner can normally be reached on Mon-Fri, 2 p.m.-10 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jill Warden/

Supervisory Patent Examiner, Art Unit 1797